



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

In re

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:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to question 36 of the morning section and questions 13, 16 and 23 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On February 4, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 36 and afternoon questions 13, 16 and 23. Petitioner's arguments for these questions are addressed individually below.

Morning question 36 reads as follows:

36. The claims of a pending patent application were rejected in an Office action mailed Thursday, November 23, 2000. The Examiner set a three-month shortened statutory period for reply. The applicant petitioned for a one-month extension of time on Friday, February 23, 2001 and paid the appropriate one-month extension fee. No further papers or fees were submitted and the application became abandoned. What was the date of abandonment?

- (A) Friday, February 23, 2001.
- (B) Friday, March 23, 2001.
- (C) Saturday, March 24, 2001.
- (D) Monday, March 26, 2001.
- (E) Thursday, May 24, 2001.

The model answer is selection (C).

The one-month extension of time filed February 23, 2001 properly extended the deadline for reply to Friday, March 23, 2001. When a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired, i.e., the application was abandoned at 12:01 AM on Saturday, March 24, 2001. The fact that March 24 was a Saturday does not change the abandonment day because the reply was due on March 23, a business day. MPEP § 710.01(a).

The petitioner argues that answer (E) is the most correct. The petitioner contends that an application does not become abandoned until the end of the six-month statutory period. Petitioner argues that 37 CFR 1.136(2) [sic] and the wording on form PTO-326 support his contention because they reference a period of extension of time. In addition, petitioner argues that since applicant may reply after the expiration of the shortened statutory period with an appropriate extension of time, the application would not become abandoned until after the maximum statutory period of six months.

The petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that an application will not become abandoned prior to the six-month statutory period, the application became abandoned on March 24, 2001 at 12:01 AM. 35 U.S.C. § 133 and 37 CFR 1.134 states that the maximum statutory period is six months and gives the authority to set a shortened **statutory** time period for reply (emphasis added). Therefore, when the examiner sets a shortened statutory time period for reply, applicant must reply within that shortened statutory time period to avoid abandonment of the application, pursuant to 37 CFR 1.135(a). 37 CFR 1.136(a) allows applicant to extend the shortened statutory time period to up to six months from the mailing date of the Office action if applicant files a petition for an extension of time and the fee set forth in 37 CFR 1.17(a).

The facts of the question clearly state that the examiner set a shortened statutory period of three months for reply in the Office action mailed on November 23, 2000, which means that applicant was required to reply by February 23, 2001 to avoid abandonment of the application as set forth in 37 CFR 1.135. In addition, the facts of the

question state that applicant timely petitioned for a one-month extension of time, which gave applicant until March 23, 2001 to reply to avoid abandonment of the application. Furthermore, the question clearly states that no further papers or fees were submitted, which means that applicant never filed a complete and proper reply, a bona fide attempt at a complete and proper reply, or another petition for an extension of time. The fact that applicant could have filed a further extension of time prior to May 24, 2001 does not effect the date the application went abandoned because it is clear from the facts that applicant did not file such a request. As stated in the Model Answer and in MPEP 710.01(a), “[w]hen a timely reply is ultimately not filed, the application is regarded as abandoned after midnight of the date the period for reply expired.” Therefore, the application went abandoned on March 24, 2001. Accordingly, answer (C) is correct and petitioner’s answer (E) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. Which of the following statements about the disclosure of the utility of an invention is true in accordance with proper USPTO practice and procedure?

(A) A claimed utility invention that is disclosed to be neither a machine, an article of manufacture, a composition, nor a process is patentable in accordance with the patent law.

(B) In a patent application claiming a compound, a disclosure by the applicant that the compound may be useful in treating unspecified disorders would be sufficient to define a specific utility for the compound.

(C) In a patent application claiming a compound, a disclosure by the applicant that the compound has “useful biological” properties, would be sufficient to define a specific utility for the compound.

(D) In a patent application claiming a compound, a disclosure by the applicant that the compound has a specific biological activity and reasonably correlates that activity to a disease condition would be sufficient to define a specific utility for the compound.

(E) If a claimed invention does not have utility, the specification nevertheless can enable one to use it.

The model answer is selection (D).

MPEP § 2107(I), “‘Real World Value’ Requirement.” The USPTO regards assertions falling within this category as sufficient to identify a specific utility for the invention. (A) is not correct. An invention that is not a machine, an article of manufacture, a composition, or a process cannot be patented. 35 U.S.C. § 101; MPEP § 2107; see

*Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980); and *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). (B) and (C) are incorrect. The USPTO regards assertions in choices (B) and (C) as insufficient to define a specific utility for the invention, especially if the assertion takes the form of a general statement that makes it clear that a “useful” invention may arise from what has been disclosed by the applicant. *Knapp v. Anderson*, 477 F.2d 588, 177 USPQ 688 (CCPA 1973). (E) is incorrect. 35 U.S.C. §§ 101, and 112; and see *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

The petitioner argues that answer (A) is the most correct for two reasons. First, the petitioner contends that the language “or any new and useful improvements thereof” in 35 U.S.C. § 101 renders the statement in answer (A) to be true. The petitioner argues that a new and useful improvement of a process, machine, manufacture, or composition of matter does not fall into the categories in answer (A). Second, the petitioner states that “case law and history has given that language much more considerable breadth than what is implied in choice A.”

The petitioner’s arguments have been fully considered but are not persuasive. In regards to petitioner’s first argument, 35 U.S.C. § 101 sets forth what inventions can be patented. The phrase “or any new and useful improvements **thereof**” (emphasis added) clearly refers back to the early phrase “process, machine, manufacture, or composition of matter.” Therefore, a new and useful improvement of a process, machine, manufacture or composition of matter must fall into one or more of the categories listed in answer (A) (e.g., “a machine, an article of manufacture, a composition, or a process”). In regards to petitioner’s second argument, the fact that subsequent court cases have further defined what is included in the categories in 35 U.S.C. § 101, does not alter the fact that an invention must fall into one of the categories in 35 U.S.C. § 101 to be patentable. While petitioner correctly points out that the Supreme Court in *Diamond v. Chakrabarty* did expand on the former interpretation of 35 U.S.C. § 101, this opinion is consistent with the patentable categories set forth by Congress and did not overrule the statute as being unconstitutional. Therefore, 35 U.S.C. § 101 is still a valid statute and must be adhered to by patent applicants. Accordingly, petitioner’s answer (A) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 16 reads as follows:

The following facts apply to Questions 14 through 16.

Thomas filed a nonprovisional utility patent application in the USPTO on February 8, 2001. The application as filed included a specification and claims in compliance with 35 U.S.C. § 112, three sheets of publication quality drawings, an abstract of the disclosure, and an application data sheet listing the name and address of the inventor. The application was initially filed without an executed inventor’s oath or declaration and without the required filing fee. The Office issued a “Notice to File Missing Parts – Filing

Date Granted” on April 2, 2001. The Notice informed Thomas that he must submit an executed oath or declaration by the inventor, pay the required filing fee, and pay a surcharge for late submission of these items within two (2) months of the date of the Notice. Thomas received the Notice on April 9, 2001. Thomas was occupied with other matters and did not file a reply in full compliance with the Notice until September 3, 2001. A Petition for a three- month extension of time and all required fees accompanied the reply. A first substantive Office action on the merits of the application issued January 21, 2002 and set a three- month shortened statutory time period for reply. All pending claims were rejected on the basis of prior art. Thomas filed a fully responsive Amendment on April 15, 2002, and a final Office action issued September 12, 2002 with a three- month shortened statutory period for reply. The final Office Action allowed certain claims and rejected other claims on substantially the same grounds set forth in the first Office action. Thomas filed a Notice of Appeal on October 21, 2002 and an Appeal Brief on April 18, 2003. A Petition for extension of time and proper authorization to charge a deposit account for any required fees accompanied the Appeal Brief. An Examiner’s Answer issued on May 2, 2003, and Thomas filed a Reply Brief on May 15, 2003. The Board of Patent Appeals and Interferences affirmed the Examiner’s rejections on September 17, 2003. With regard to the allowed claims, a Notice of Allowance and Issue Fee Due was mailed October 3, 2003. Thomas paid the Issue Fee on October 20, 2003 and the patent issued March 23, 2004.

16. In addition to the facts set forth in connection with the previous two questions, Thomas’ application had not and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing. At the time he filed his application in the USPTO, Thomas submitted a nonpublication request and supporting materials that fully complied with all requirements for nonpublication of the application at 18 months. Which of the following statements is most correct?

- (A) Thomas may rescind his nonpublication request at any time.
- (B) By requesting nonpublication of the application, Thomas “opted out” of the statutory framework for patent term adjustment and, therefore, no patent term adjustment is available.
- (C) Submission of the nonpublication request does not affect any patent term adjustment that might be available to Thomas.
- (D) Statements (A) and (C) are true.
- (E) Statements (B) and (C) are true.

The model answer is selection (D).

Nonpublication of the application does not affect the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Thus, statement (C) is true. The patent term

adjustment provisions of 37 CFR 1.702 et seq. are separate and independent of the eighteen-month publication provisions. There is no support for statement (B). An applicant may rescind a nonpublication request at any time. 37 CFR 1.213(b), and see “37 CFR Parts 1 and 5 – Changes To Implement Eighteen-Month Publication of Patent Applications; Final Rule,” Federal Register Vol. 65, No. 183 (9/20/2000) at 57024. Thus, statement (A) is also true. Accordingly, the best answer is (D).

The petitioner argues that answer (A) is the most correct because he contends that answer (C) is not entirely accurate. The petitioner argues that the phrase “patent term adjustment” does not refer to the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Petitioner does state, however, that the same phrase “patent term adjustment” in answer (B) does refer to the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Petitioner further argues that since “patent term adjustment” is anything that effects the patent term, a request for nonpublication affects the patent term in that applicant will not be able to assert provisional rights to recover possible damages prior to issuance of the patent. Therefore, petitioner contends that since answer (C) is not correct, answer (A) is the most correct.

The petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the phrase “patent term adjustment” refers to anything that affects patent term, the phrase “patent term adjustment” is clearly a term of art that refers to the patent term adjustment provisions of the Patent Term Guarantee Act of 1999. Even assuming petitioner’s definition of “patent term adjustment” is correct, a request for nonpublication does not affect patent “term,” although it may affect their patent rights. The term of the patent is the time period in which it can be enforced. The term of the patent does not start until the patent issues. See 35 U.S.C. § 154(a)(2). The provisions providing provisional rights (35 U.S.C. § 154(d)) do not extend the patent term, but instead give additional patent rights that can only be enforced after the patent issues. Accordingly, answer (C) is correct in addition to answer (A) being correct, which means that answer (D) is the most correct answer.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 23 reads as follows:

23. Greene is a registered patent agent employed by an intellectual property law firm located in Arlington, Virginia. Greene is awakened at 5:30 AM one morning by a frantic call from Whyte, a senior partner at the law firm. Whyte informs Greene that Whyte has an examiner interview scheduled for 3:00 PM that day in connection with an important patent application Whyte is handling. However, a family emergency arose during the night and Whyte will not be able to attend the interview. It is also the last day of the statutory six-month period for reply, so the interview cannot be rescheduled. Whyte requests that Greene conduct the examiner interview for Whyte and, based on the outcome of the interview, file appropriate papers with the Patent Office. Whyte tells



Greene exactly where Greene can locate the file in Whyte's office. Greene has not been given a power of attorney in the application, but has been given a power to inspect the Patent Office file for the application. Assuming Greene has adequate time to prepare for the interview and will competently represent the applicant, which of the following statements is true?

(A) Greene must obtain either a written power of attorney from the applicant or a written associate power of attorney from Whyte before Greene can participate in the examiner interview.

(B) Greene can participate in the interview if Greene brings along a copy of the application file and states to the examiner that Greene is authorized to represent the applicant.

(C) Greene cannot participate in the examiner interview because Greene does not have an express power of attorney and has not previously made an appearance in the application.

(D) A mere power to inspect is sufficient authority for an examiner to grant an interview involving the merits of an application.

(E) Statements (B) and (D) are true.

The model answer is selection (B).

MPEP § 713.05. Statements (A) and (C) are incorrect because Greene may participate in the interview if he possesses a copy of the application file and states he is authorized to represent the applicant. (D) is incorrect because a mere power to inspect is insufficient authority for an examiner to grant an interview involving the merits of an application. *Id.* (E) is therefore also incorrect.

The petitioner argues that none of the answers are correct. The petitioner contends that Greene's statement that he is authorized to represent the applicant to the examiner is in violation of 37 CFR 10.23(b)(4) since Greene has not been given power of attorney. Therefore, answer (B) is incorrect because none of the answers are correct, as explained by the petitioner.

The petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's arguments that Greene's statement would be a violation of 37 CFR 10.23(b)(4), a registered attorney or agent, which Greene is, can appear in person before the USPTO and his personal appearance shall constitute a representation that he is authorized to represent the applicant. See 37 CFR 1.34(a). Greene's statement for recognition of representation is different from a statement asserting that he has power of attorney. Greene has a good faith basis for his statement regarding recognition of representation by his conversation with Whyte. Therefore, Greene's statement regarding representation was not a violation of 37 CFR 10.23(b)(4). Greene can participate in the

interview based on the file he brought with him in accordance with MPEP § 713.05. Accordingly, answer (B) is correct.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, no points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above the printed name and title.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy